

Remarks

Kindly note that the remarks regarding the papers mailed August 4, 2010 do not discuss the cancelled claims.

35 U.S.C. §102 rejections

In the papers mailed August 4, 2010 claim 46 and claim 48 were rejected under 35 USC §102(b) as being anticipated by Bielinski. The author of the papers mailed August 4, 2010 has cited the Bielinski document as a reference. The Assignee traverses the rejections for anticipation in a three ways.

1. First, by noting that the claim rejections fail under both standards of the Administrative Procedures Act and are therefore moot.
2. Second, by noting that there is no statutory basis for the claim rejections as the claim rejections were authored by an individual and an organization with an apparently well documented lack of average or ordinary skill in the relevant arts. It is well established that patent examination needs to be completed "in light of the specification as it would be interpreted by one of ordinary skill in the art." (In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364, 70 USPQ2d 1827 Fed. Cir. 2004).
3. Third, by noting that the Office Action has failed to establish a prima facie case of anticipation. In particular, the papers mailed August 4, 2010 fails to establish a prima facie case of anticipation for the rejected claims by: citing a document that does not explicitly or inherently describe one or more limitation for every claim, citing a document that does not have the same level of detail included in the rejected claims, by citing a document that does not arrange the limitations in the same way they are arranged in the rejected claims and by citing a document that describes an invention that would require substantial experimentation to match the functionality of the claimed invention. As summarized in previously filed declarations, the cited document provides substantial evidence of the novelty, non-obviousness and newness of the claimed invention. .

Furthermore, the claim rejections are moot because claim amendments are believed to have obviated these rejections.

35 U.S.C. § 103 rejections

In the papers mailed August 4, 2010 claim 36, claim 37, claim 38, claim 39, claim 41, claim 42, claim 47, claim 55, claim 58, claim 59 and claim 60 are rejected under 35 USC §103(a) as being unpatentable over Bielinski alone or in view of Baur. The author of the papers mailed

August 4, 2010 has cited these two documents as references. In the papers mailed August 4, 2010, claim 40, claim 49, claim 50, claim 51, claim 52, claim 56 and claim 57 are rejected under 35 USC §103(a) as being unpatentable over Bielinski alone or in view of Baur and: Bigus (claim 40), Stork (claim 50), Mauboussin (claim 49, 51, 52 and 56) and Davis (claim 57). The Assignee respectfully traverses the §103(a) rejections of claim 36, claim 37, claim 38, claim 39, claim 40, claim 41, claim 42, claim 47, claim 49, claim 51, claim 52, claim 55, claim 56, claim 57, claim 58, claim 59 and claim 60 in several ways.

1. First, by noting that the assertions regarding the alleged obviousness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot.
2. Second, by noting that there is no statutory basis for the claim rejections as the claim rejections were authored by an individual and an organization with an apparently well documented lack of average or ordinary skill in the relevant arts. It is well established that a review for compliance with 35 U.S.C. 103 conditions for patentability requires a determination as to whether or not the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
3. Third, by noting that the cited combination of documents fails to establish a prima facie case of obviousness. The papers mailed August 4, 2010 fails to establish the required prima facie case of obviousness in a number of ways, including: by: citing combinations of documents that teach away from the claimed invention, citing a combination of documents that fails to teach one or more limitation for every claim, failing to explain the combination as required by KSR v Teleflex, teaching a combination that requires a change in principle of operation of the disclosed inventions and teaching a combination that would destroy the ability of one or more of the inventions to function.

Furthermore, the claim rejections are moot because claim amendments are believed to have obviated these rejections.

35 U.S.C. §112 first paragraph rejections

In the papers mailed August 4, 2010 claim 36, claim 37, claim 38, claim 39, claim 41 and claim 42 are rejected under 35 USC §112 first paragraph for allegedly not describing a physical object or substance. The Assignee traverses the §112 first paragraph rejection of claim 36, claim 37, claim 38, claim 39, claim 41 and claim 42.

1. First, by noting that the assertions regarding the alleged lack of written description are not in compliance with the both standards of the Administrative Procedures Act and are therefore moot.
2. Second, by noting that there is no statutory basis for the claim rejections. The claim rejections are non-statutory because there is no statutory basis for giving any consideration to a written description rejection authored by individuals and/or an organization with an apparent level of skill in the art that is not average or better. The written description rejections add to the clear and convincing evidence that the author of said papers and said organization appear to lack the level of skill in the art required to complete a statutory patent examination.
3. Third, by noting that the papers mailed August 4, 2010 have failed to establish a prima facie case that the specification does not meet the requirements of §112 first paragraph. In particular, the author of said papers has failed to note that *“there is no requirement that the words in the claim must match those used in the specification disclosure”* and that the use of words in a claim that do not match those used in the specification does not comprise the incorporation of new matter (see *In re Robert Skvorecz, CAFC 2008-1221*).

Furthermore, claim amendments have obviated these claim rejections.

35 U.S.C. §112 second paragraph rejections

In the papers mailed August 4, 2010 claim 36, claim 37, claim 38, claim 39, claim 41, claim 42, claim 46 and claim 55 are rejected under 35 U.S.C. §112 second paragraph. The Assignee traverses the §112 second paragraph rejection of claim 36, claim 37, claim 38, claim 39, claim 41, claim 42, claim 46 and claim 55 in several ways.

1. First, by noting that the assertions regarding the alleged lack of written description are not in compliance with the both standards of the Administrative Procedures Act and are therefore moot.
2. Second, by noting that there is no statutory basis for the claim rejections. The claim rejections are non-statutory because there is no statutory basis for giving any consideration to a written description rejection authored by individuals and/or an organization with an apparent level of skill in the art that is not average or better.

3. Third, by noting that the papers mailed August 4, 2010 have failed to establish a prima facie case that the specification does not meet the requirements of §112 second paragraph. In particular, the Assignee notes that the arguments presented by the author of said papers fail to establish the prima facie case required to sustain a §112 second paragraph rejection. *MPEP 2173.02 states that: definiteness of claim language must be analyzed, not in a vacuum, but in light of:*

(A) The content of the particular application disclosure;

(B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001). In the case of claim 36, claim 37, claim 38, claim 39, claim 41, claim 42, claim 46 and claim 55 the author of said papers has failed to establish the prima facie case that the specification does not meet the requirements of §112 second paragraph in at least four ways for every rejected claim. The four ways are: by failing to interpret the claims in light of the specification, by failing to provide any evidence that someone of average skill in the relevant arts would have difficulty interpreting the claims, by failing to establish that the limitation(s) in the claims fail to describe the invention and/or by failing to consider the claim as a whole.

These failures may be due to the fact that those authoring the papers mailed August 4, 2010 do not appear to understand any of the scientific and/or engineering principles applicable to the pertinent art.

Furthermore, claim amendments have obviated these claim rejections.

Copending applications

Under the provisions of MPEP § 2001.06(b), the author of the papers mailed August 4, 2010 is hereby advised of information obtained from co-pending U.S. Patent Application(s) which may

be "material to patentability" of the instant application (see *Armour & Co. v. Swift & Co.*, 466 F.2d 767, 779, 175 USPQ 70, 79 7th Cir. 1972).

A review of co-pending applications has revealed that the apparently routine allowance and issue of patents to large companies for "inventions" that do not appear to meet the requirements for allowance (i.e. novelty, written description, etc.) appears to be having a material, negative impact on the prosecution of the assignee's patent applications. In accordance with the prevailing statutes, the allowance and issue of patents to large companies for inventions that do not appear to meet the requirements for allowance should not have any impact on the prosecution of Asset Trust patent applications. In fact, the U.S.P.T.O. has a professed commitment and a legal obligation to invalidate patents that do not meet the legal requirements for patentability. Unfortunately, the U.S.P.T.O. appears to be shielding the patents issued to large companies for "inventions" that do not appear to meet the statutory requirements for allowance instead of honoring their statutory obligation to invalidate them. In particular, the Assignee has recently determined that the primary reasons it has been forced to file over twenty appeals all appear to be related to efforts to bolster patents issued to large companies for inventions that do not appear to be novel. These reasons include:

- 1) the need to traverse apparent misrepresentations that prior art that should properly be used to prevent the allowance of (or invalidate) one or more patents issued to a large company is relevant to an Asset Trust patent application. This is the single largest reason the Assignee has been forced to file so many appeals. For example, one reference used to support claim rejections in co-pending application 11/262,146 was SEAL. Among other things SEAL teaches the use of a "semantic similarity measure" for identifying relevant information. As detailed in prior communications, this teaches away from the claimed invention that relies on a mission oriented context model. Of note is the fact that SEAL was not cited during the prosecution of U.S. Patent 7,644,047 which relies on semantic similarity measures for identifying relevant information. In a similar manner, the primary reference used to support the rejection of the claims in co-pending application 11/262,146 is Cheverst (aka GUIDE). A comparison on the key features of Cheverst to the features of the invention claimed in co-pending application 11/262,146 and the features of the invention claimed in U.S. Patent 7,474,960 shows that Cheverst appears to be a much closer match to the issued patent than it is to the rejected claims in the co-pending application.

Feature	Cheverst/GUIDE	7,474,960	11/262,146
Primary device	Mobile device	Vehicle with computing device	Personal computer
Primary application	Identify the best route for touring a city for a given location, weather and interests, has a map option	Identify the best route for a given context in a context map	Develop a context model and use it to identify actions that optimize an enterprise performance
Context information	Location, user interests, weather	Location, points of interest, geography	Physical (location, amount), social environment, tactical, instant, organization, mission
Context model created?	No	No	Yes
Data sources	Wireless network, Internet	Wireless networks, Internet, vehicle orientation processor	Enterprise applications, Internet
SW architecture	Client server	Client server	Layered, client server

This practice appears to have been utilized in the instant application as a number of issued patents (i.e. Davis, 6,732,095) appear to be much closer to the references cited during the prosecution of the instant application than they are to the claimed invention.

2) the need to traverse apparent misrepresentations that one or more patents issued to a large company for an "invention" that does not appear to meet the requirements for patentability is relevant to an Asset Trust patent application. This practice appears to have been relied upon during the prosecution of the instant application as it is unlikely that the reference, Davis, would have issued if Ranger and Bowman-Amuah been properly considered during prosecution.

3) the need to traverse rejections apparently made without explanation that inventions similar or identical to those found in patents issued to large companies represent non-statutory subject matter. As detailed in prior communications, this clearly applies to the instant application.

4) the apparently improper use of Official Notice. As noted above, this practice has been relied upon to reject the claims in the instant application.

5. the need to traverse rejections apparently made without evidence that methods and/or claims similar or identical to those found in patents issued to large companies are "too subjective" and/or not enabled. As noted above, this practice has been relied upon to reject the claims in the instant application.

6. the need to traverse rejections made for informalities.

7. the need to overcome actions taken by U.S.P.T.O. personnel in apparent violation of one or more statutes, rules or established precedents. These actions appear to be concentrated in Asset Trust applications with pending claims that appear to be similar to those in prima facie invalid patents previously issued to one or more large companies.

The subject matter contained in the discussion above may be deemed to relate to the present application, and thus may be felt (with or without reasonable justification) to be material to the prosecution of this instant application.

☐ Copies of cited U.S. patent application(s) (office actions, specification, claims, and the drawings) or copies of the portion(s) of the application(s) which caused it(them) to be cited, including any claims directed to such portion(s) are attached hereto.

☒ Copies of the cited U.S. Patent Application(s) (office actions, specification, claims, and the drawings) and U.S. Patents are available on the U.S.P.T.O.'s Image File Wrapper. Therefore copies thereof need not be attached.

☐ The materials in the envelope are considered trade secrets and are being submitted for consideration under MPEP § 724.

The above-listed co-pending application(s) is not to be construed as prior art. By bringing the above-listed application(s) to the attention of the author of the papers mailed August 4, 2010, the Assignee does NOT waive any confidentiality concerning the above-listed co-pending application(s) or this application. See MPEP §101. Furthermore, if said application(s) should not mature into patents, such application(s) should be preserved in secrecy under the provisions of 35 U.S.C. § 122 and 37 C.F.R. § 1.14.

Acknowledgement

The Assignee previously requested: an unbiased patent application examination conducted by an Examiner with knowledge of the relevant arts who follows the law for the instant application. The Office's apparent failure to provide such an examination for the instant application is taken as an acknowledgment that no personnel with the requisite level of skill in the art and/or training in the relevant statutes and precedents are available at the present time. As a result, the instant application has yet to receive its first examination.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after

consideration of the references cited or the objections made. The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons claims was amended was to correct inadvertent correct clerical errors and to put the claims into final form for allowance and issue.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President
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